

REMARKS

By this Amendment, Applicants amend claims 27, 78, and 83, and add new claims 90-101. The originally filed specification, drawings, and claims fully support the subject matter of the amended claims 27, 78, and 83, and new claims 90-101. No new matter has been introduced.

Before entry of this Amendment, claims 1-12, 14-25, 27, and 78-89 were pending in this application. After entry of this amendment claims 1-12, 14-25, 27, and 78-101 are pending. Claims 1 and 14 are the sole independent claims.

Rejection of Claims 1-7, 9-12, 14-20, 22-25, 27, 78-80, 83-85, and 89 under 35

U.S.C. § 103(a)

On page 3 of the Office Action, claims 1-7, 9-12, 14-20, 22-25, 27, 78-80, 83-85, and 89 were rejected under 35 U.S.C § 103(a) as being unpatentable over International Publication Number WO 01/30242 to Paternuosto ("Paternuosto"). Applicants respectfully traverse the rejection.

With regard to independent claims 1 and 14, pages 3-5 of the Office Action allege that the portion of container element 22 around hole 18 corresponds to the claimed "open top," opening 24 in the base wall of container element 22 corresponds to the claimed "open bottom," and opening 24 "itself is a restriction for keeping biopsy samples in the device." In formulating the Section 103(a) rejection, the Office Action concedes that "Paternuosto does not disclose that the restriction is an hour-glass shape that defines a restriction smaller than the open bottom." The Office Action, however, asserts that it would have been an obvious matter of "design choice" to modify Paternuosto to disclose the claimed features recited in independent claims 1 and 14

ostensibly “because Applicant has not disclosed that the hour glass shape provides an advantage, is used for a particular purpose, or solves a stated problem.” See pages 4 and 5 of the Office Action. The Office Action further asserts that it would have been obvious to one of ordinary skill in the art to “have expected Paternuosto's opening at the bottom of the container, and [A]pplicant's invention, to perform equally well with either the opening taught by Paternuosto or the claimed hour-glass shape because both types of openings would perform the same function of preventing [a] biopsy sample from falling-out equally well considering the typical size of [a] biopsy sample.” The Office Action concluded that it would have been obvious to modify Paternuosto because “such a modification would have been considered a mere design consideration.” See pages 4 and 5 of the Office Action. Applicants respectfully traverse the rejections for at least the following reasons.

First, Applicants respectfully disagree with the Office Action's characterization that Applicants have not disclosed the advantages, purpose, or solutions posed by the hour-glass shape. The specification states that the hour-glass shape, for example, prevents the tissue samples from exiting the container via the open bottom and couples the elongate container to a flush adapter for tissue sample removal. More specifically, the specification states that “[a]t the bottom end of the pouch container 74 opposite the base wall 72 is a flush adapter interface 79 configured to be coupled with a flush adapter 110.... The flush adapter interface 79 has a roughly hourglass shape that defines a flush passage 78 that is open at its bottom.” See paragraph [0051] of the present Application Publication No. US 2005/0054945 A1 (“the ‘945 publication”). The specification further states that “[t]he flush adapter interface 79 receives flush nozzle

121 [of the flush adapter 110] such that the flush nozzle 121 is placed in the flush passage 78 of the flush adapter interface 79. The flush nozzle 121 may be lodged sufficiently in the flush passage 78 such that a watertight seal is formed, and the hollow central shaft of hypotube 120 is in fluid communication with the flush passage 78.” See paragraph [0075] of the ‘945 publication. In this manner, fluid can be delivered through the flush adapter to flush the tissue samples out of the cavity via the open top. See paragraphs [0013], [0075], and [0077] of the ‘945 publication. As is apparent from Figures 3, 5A, and 5B of the specification, the bottom funnel portion of the hour-glass shape receives and will guide flush nozzle 121 into the throat portion of the flush adapter interface, where nozzle 121 forms the fluidtight seal. In addition, the length of nozzle 121 may correspond to the length of the bottom funnel portion and the throat of the hour-glass shape, so that the end of nozzle 121 does not extend past the throat. In this way, the end of nozzle 121 will not damage or otherwise disturb the integrity of the biopsy samples.

Second, even if the opening 24 at the bottom of container element 22 of Paternuosto and the claimed hour-glass shape prevent biopsy samples from falling out equally well, as the Examiner suggests (and to which Applicants do not necessarily concede), opening 24 is not disclosed as configured in any manner to be coupled to a flush adapter. As described above, for example, the claimed elongate container is configured, as examples, to receive the flush nozzle of the flush adapter within the restriction of the hour-glass shape, provide a watertight seal, and preserve the integrity of the tissue samples stored within the cavity of the container. Opening 24 is not configured to achieve each of these advantages and purposes.

Therefore, absent disclosure by Paternuosto of the required structural limitations of independent claims 1 and 14, the 35 U.S.C. § 103(a) rejection based on Paternuosto does not render independent claims 1 and 14 obvious. Accordingly, Applicants respectfully request withdrawal and reconsideration of the 35 U.S.C. § 103(a) rejection of independent claims 1 and 14. Dependent claims 2-12, 78-82, and 89 depend from claim 1 and are allowable at least because of their dependency from independent claim 1. Dependent claims 15-25, 27, and 83-88 depend from claim 14 and are allowable at least because of their dependency from independent claim 14.

Rejection of claims 8, 21, 81-82, 86-87, and 88 under 35 U.S.C. § 103(a)

On pages 8-10 of the Office Action, dependent claims 8 and 21 were rejected under 35 U.S.C § 103(a) as being unpatentable over Paternuosto as applied to claims 1-7, 9-12, 14-20, 22-25, 27, 78-80, 83-85, and 89 above, and further in view of U.S. Patent No. 5,662,671 to Barbut et al. ("Barbut"); dependent claims 81-82 and 86-87 were rejected under 35 U.S.C § 103(a) as being unpatentable over Paternuosto as applied to claims 1-7, 9-12, 14-20, 22-25, 27, 78-80, 83-85, and 89 above, and further in view of U.S. Patent No. 2,778,357 to Leibinger et al. ("Leibinger"); and dependent claim 88 was rejected under 35 U.S.C § 103(a) as applied to claims 1-7, 9-12, 14-20, 22-25, 27, 78-80, 83-85, and 89 above, and further in view of U.S. Patent No. 4,763,669 to Jaeger ("Jaeger"). Applicants respectfully traverse these rejections. As set forth above, Paternuosto does not disclose or suggest every aspect of independent claims 1 and 14. Neither Barbut, Leibinger, nor Jaeger remedy the deficiencies of Paternuosto. The rejections, for example, rely on Barbut and Leibinger for their alleged disclosure relating to features of the upper jaw recited in the dependent claims and rely on Jaeger for its

alleged disclosure relating to features of the cutting portion. Applicants therefore respectfully request withdrawal of the Section 103(a) rejection of claims 8 and 21 based on Paternuosto and Barbut, the Section 103(a) rejection of claims 81-82 and 86-87 based on Paternuosto and Leibinger, and the Section 103(a) rejection of claim 88 based on Paternuosto and Jaeger.

In addition, in rejecting claim 88, the Office Action asserts that “Jaeger teaches a cutting portion (cutting section 112 Figures 11 and 12) that includes a circumferential groove configured to receive a protrusion (cutting section 110 meeting cutting section 112, Figure 12, and Column 8 lines 44-47).” See page 10 of the Office Action. Applicants respectfully disagree with the Office Actions characterization’s and assertions.

Jaeger discloses that cutting section 112 extends from scissor blade 108 and cutting section 110 extends from scissor blade 106. As illustrated in Fig. 11, scissor blades 106, 108 are planar, and therefore, cannot have a “circumferential” groove. Also, the alleged “groove” of double-edged cutting section 112 is configured to receive a single-edged cutting section 110 on blade 106. That is, Jaeger does not disclose that doubled-edged cutting section 112 is configured to “receive a protrusion” of a container, as recited in dependent claim 88. Finally, Applicants submit that one skilled in the art would have no motivation to modify the already secured attachment of container element 22 to half-shell 10b of Paternuosto.

For at least these reasons, the Office Action’s proposed combination of Paternuosto and Jaeger fails to render claim 88 unpatentable. Accordingly, Applicants

respectfully request withdrawal and reconsideration of the 35 U.S.C. § 103(a) rejection of dependent claim 88.

New Claims 90-101

By this Amendment, Applicants have added new dependent claims 90-101. The subject matter of new claims 90-101 is fully supported by the originally filed specification, claims, and drawings. No new matter is added.

Applicants acknowledge that in a Restriction Requirement mailed March 13, 2007, the Examiner requested restriction under 35 U.S.C. § 121 between Group I (i.e., claims 1-27 allegedly drawn to a device for collecting and storing a plurality of tissue samples) and Group III (i.e., claims 34-45 allegedly drawn to a flushing device). In particular, the Restriction Requirement stated that “[i]nventions III and I are related as combination and subcombination... In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because for example, the claims related to invention III do not include the limitation that the device for storing a plurality of tissue samples includes a cutting portion which comprises an upper jaw and a lower jaw configured to cut tissue when the upper jaw mates with the lower jaw.” See page 3 of the Office Action. Applicants submit that each of new claims 90-102 depends from one of independent claims 1 and 14 and, thus, incorporates each and every element therein.

Furthermore, none of the cited prior art, alone or in combination, teaches or suggests the recitations of new claims 90-101. Accordingly, Applicants respectfully request examination and consideration of the newly submitted claims.

Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of prior art references cited in this application. Applicants therefore request entry of this amendment, and the timely allowance of the pending claims.

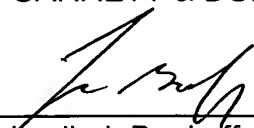
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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By: _____


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